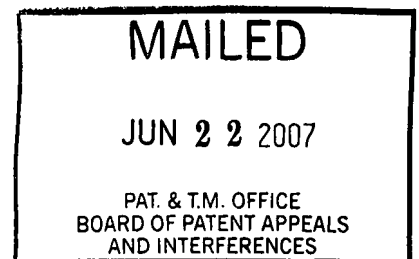


1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
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10 Ex parte CHRISTOPHER J. NASON, CRAIG FRISCH,
11 and ANDRE MOSKAL
12

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14 Appeal 2007-1127
15 Application 09/800,112
16 Technology Center 2100
17
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19 Oral Hearing Held: May 23, 2007
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23 Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and
24 ALLEN R. MACDONALD, Administrative Patent Judges.
25

26 ON BEHALF OF THE APPELLANT:
27

28 WILLIAM J. SAPONE
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33

34 The above-entitled matter came on for hearing on Wednesday, May
35 23, 2007, commencing at 10:30 a.m., at The U.S. Patent and Trademark
36 Office, 600 Dulany Street, Alexandria, Virginia.

1 MR. SAPONE: Good morning, Your Honor.

2 JUDGE THOMAS: You can proceed at anything.

3 MR. SAPONE: I guess the first thing we should do is maybe dispose
4 of this recent issue, which is KSR has come up since the briefs and papers
5 were filed, and whether or not that might have an impact on the appeal at
6 present.

7 And I would just give my opinion that I don't believe it really
8 changes the outcome. KSR basically dealt with -- basically two different
9 patents with sort of two different functioning devices. There was "A" plus
10 "B" gives you the invention, and I think that the court was pretty clear on
11 that.

12 In this case, we have two references and it is an obviousness
13 rejection, but we don't have "A" plus "B". The problem is, there is no "B"
14 for either of these references, which is why the invention is not obvious.

15 The invention in claim 22 relates to a protocol header and a way of
16 messaging so that an internet protocol device can communicate with a PBX.
17 And the way they do that is clever. They reconfigure the messaging between
18 the two so that you encapsulate the non-IP device messages and then you
19 transmit them back and forth with a protocol header which identifies how
20 that is supposed to be read by the PBX.

21 If you look at the two references that are recited, the first reference
22 deals with the problem by taking the IP device and basically you are trying
23 to fake out the PBX by calling it a radio telephone. And that way, you can
24 integrate the messages from that phone by translating it into a radio
25 telephone device.

1 And the second reference is basically a gateway path, which
2 discusses two different PBX systems and how they are going to
3 communicate by having gateways which translate messages and -- between
4 the two, there are microcomputers to translate in the gatekeeper to keep
5 things going back and forth.

6 The present invention doesn't use the gatekeeper. It uses the PBX
7 and the IP phones and the non-IP phones. And it is able to have these
8 communicate by altering the messaging. And I think that is really what the
9 significant part of the invention is and why it is not found in the prior art.

10 I read through many times these references that are cited by the
11 Examiner and tried to find where he located the protocol header, which tells
12 whether or not the message has been encapsulated and what the header --
13 what the protocol was, and I couldn't find it.

14 There is address information that is transmitted, which is fairly
15 standard, but nothing that relates to a protocol header, nothing that relates to
16 encapsulating a non-IP message and then transmitting that to a PBX and it
17 being able to interpret that and read it so that the two can communicate.

18 And that's really the heart of the case.

19 JUDGE THOMAS: Any questions?

20 JUDGE MacDONALD: I only have one. I think, though, that you
21 have already answered it -- but I want to double check.

22 MR. SAPONE: Sure.

23 JUDGE MacDONALD: When I looked at the claim, I thought the
24 heart of this was really a data structure that provided certain control
25 information. The data structure comprising the protocol header and the IP
26 message body and then you further define the structure of the protocol

1 header as the three items, and, as you said, the address portion of that is
2 fairly standard.

3 Although the one thing that concerned me is the statement that the
4 protocol type -- and I think that argument was in the brief also was not
5 taught in the reference -- and I know you and the Examiner went back and
6 forth about that.

7 But when I read through the reference, I was a little concerned that I
8 thought there was specific language in there talking about a protocol ID
9 being part of a typical message.

10 It wasn't in the section. It was discussed --

11 MR. SAPONE: I understand that. That's why it isn't just protocol
12 type. I mean, this is specifically defined in the claim as a protocol type for
13 denoting whether the message is either an IP message or an encapsulated
14 non-IP message.

15 So now, we are not just talking protocol type in general, which
16 people can define. We are looking for a particular one, which allows these
17 two devices to communicate.

18 JUDGE MacDONALD: Well, that was another thing that I was
19 concerned about here. There was a statement in the brief that as to the
20 functionality that was accomplished by having these two types of
21 information, yet that functionality isn't in the claims anywhere.

22 MR. SAPONE: Well, the functionality is inherent in what a PBX
23 system can do for the IP phone and a non-IP phone. A PBX provides all the
24 call-forwarding, and all the different features and functionalities.

25 JUDGE MacDONALD: But the PBX is an off-the-shelf device. If
26 you don't tell the public that my protocol type is going to modify

1 functionality in the following way, if you don't put it in your claim, it is kind
2 of hard for the public to understand that that's the intent of your claim.

3 MR. SAPONE: Well, the intent of the claim is to let both IP and
4 non-IP devices work with the same PBX.

5 And I think people in this field will recognize what is involved in this
6 claim, and why it is important because even these other patents talked about
7 the difficulty of having non-IP devices talk with IP-devices and PBXs.

8 So, I mean, there is a known problem. And this is a nice, simple,
9 direct solution to it. And I think people skilled in the art would understand
10 that, once they have this capability, both those types of phones can
11 communicate with the PBX without the gateway and it is just a matter of
12 readjusting the way in which the two communicate.

13 And I think once they recognize that, and all the functionality of the
14 PBX is there, and they still have all the functionalities of the IP devices,
15 whatever those may be.

16 So I think that in itself would be fairly evident to people skilled in
17 the art and we are not adding any functionality to the PBX, we are just
18 letting these things communicate so that these devices can take advantage of
19 the PBX.

20 JUDGE MacDONALD: Any questions?

21 (No response.)

22 JUDGE MacDONALD: Judge Thomas?

1 JUDGE THOMAS: No. Thank you.
2 JUDGE MacDONALD: Do you have anything further?
3 MR. SAPONE: No, Your Honor.
4 JUDGE MacDONALD: Okay.
5 MR. SAPONE: Thank you.
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8 (Whereupon, the proceedings concluded.)